

REMARKS

The Office Action mailed April 10, 2008 has been carefully considered. Within the Office Action Claims 17, 24, 25, 27, 32, 33 and 35-38 have been rejected. The Applicants have amended Claims 17, 24, 25, 32 and 33 and have cancelled Claims 35 and 37. The Applicants reserve the right to further pursue the cancelled claims in a continuation and/or divisional application as well as for appeal purposes. Reconsideration in view of the following remarks is respectfully requested.

Drawings

The drawings of the present application have been objected to in the Office Action under 37 CFR 1.83(a). The Applicants respectfully traverse. However, to expedite prosecution of the present application, the second locking mechanism has been removed from Claim 17. Withdrawal of the objection is respectfully requested.

Claim Objections

Claim 37 is objected to under 37 CFR 1.75(c), as being of improper form for failing to further limit the subject matter of a previous claim. The Applicants respectfully traverse. However, to expedite prosecution of the present application, Claim 37 has been cancelled. Withdrawal of the objection is respectfully requested.

The 35 U.S.C. § 112, Second Paragraph Rejection

Claims 24, 25, 33 and 36 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject

matter that the Applicants regard as the invention. This rejection is respectfully traversed.

However, to expedite prosecution, Applicants have amended Claims 24, 25, and 33. Claim 34 refers to the housing in Claim 32, and thus has proper antecedent basis. Withdrawal of the rejections is respectfully requested.

The First 35 U.S.C. § 103 Rejection

Claims 17, 24, 32, 35 and 37 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 4,907,973 to Hon in view of U.S. Patent No. 5,820,600 to Carlson et al. (hereinafter “Carlson”). This rejection is respectfully traversed.

In determining obviousness four factual inquiries must be looked into in regards to determining obviousness. These are determining the scope and content of the prior art; ascertaining the differences between the prior art and the claims in issue; resolving the level of ordinary skill in the pertinent art; and evaluating evidence of secondary consideration. Graham v. John Deere, 383 U.S. 1 (1966); KSR Int’l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007) (“Often, it will be necessary . . . to look into related teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit.**”) (emphasis added).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713

F.2d 1530 (Fed. Cir. 1983). Thus, when considering the whole prior art reference its entirety, portions that would lead away from the claimed invention must be considered. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), See M.P.E.P. 2141.02. Thus, it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984)

Hon describes a medical investigative system with which a user interacts to train in invasive or non-invasive procedures. In particular, Figures 9 and 10 which are referred to in the office action show a simulated medical instrument being inserted within a mock body. However, there is absolutely no hint, teaching or suggestion in Hon of any portion of the body being pivotable, rotatable or otherwise moveable in a plurality of degrees of freedom, with respect to a housing having the sensing assembly therein, by use of a bracket.

Carlson is directed to an adjustable trocar valve which may be inserted into a patient's body. However, there is no teaching or suggestion as to how the trocar valve of Carlson would be used to move a mock anatomical site in a plurality of degrees of freedom with respect to the housing having the sensing assembly.

There would be no motivation for one skilled in the art to combine Hon and Carlson in reaching the claimed subject matter. As stated, Hon relates to a mock body which receives a medical simulation tool, whereby the user can perform training exercises on the mock body. There are no mock anatomical sites in Hon which are moveable. Additionally, Carlson is merely a trocar valve which is inserted into an opening in a patient. One skilled in the art would simply

not find any apparent reason in combining a trocar valve and a mock body to reach an assembly that allows the mock anatomical site to be moveable with respect to a housing in a plurality of degrees of freedom, as recited in Claims 17, 24, and 32.

Additionally, the combination of Hon and Carlson do not teach or suggest each and every element/limitation as required to establish a *prima facie* case of obviousness. First of all, Carlson does not teach or suggest even a bracket. The “bracket” recited in the office action is merely an introducer assembly and cannula 2, 4. (Carlson, Col. 7, Lines 5-10). Moreover, the combination of the references do not teach or suggest a bracket coupled to the mock anatomical site and the housing which is **configured to allow the mock anatomical site to be moveable in a plurality of degrees of freedom with respect to the housing**, as recited in Claims 17, 24 and 32.

Additionally, the combination of Hon and Carlson simply does not teach or suggest a ring and retainer **which allows the mock anatomical site to pivot with respect to the bracket**, as recited in Claims 17, 24 and 32. Furthermore, the combination of Hon and Carlson does not teach or suggest a locking mechanism which prevents movement of the mock anatomical site when locked, as recited in Claims 17, 24 and 32. For at least these reasons, the combination of references do not teach or suggest each and every element/limitation taught in the claims.

Accordingly, Claims 17, 24 and 32 are non-obvious and allowable over the cited references.

Withdrawal of the rejection is respectfully requested.

The Second 35 U.S.C. § 103 Rejection

Claims 25 and 33 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hon and Carlson as applied to claims 24 and 32 and further in view of U.S. Patent No. 5,951,301 to Younker. This rejection is respectfully traversed. However, Claims 25 and 33 are

allowable for being dependent on allowable base claims. Accordingly, withdrawal of the rejection is respectfully requested.

The Third 35 U.S.C. § 103 Rejection

Claims 27 and 36 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hon, in view of Carlson, as applied to claim 32 and further in view of U.S. Patent No. 5,480,307 to Lang et al. (hereinafter “Lang”). This rejection is respectfully traversed. However, Claims 27 and 36 are allowable for being dependent on allowable base claims. Accordingly, withdrawal of the rejection is respectfully requested.

The Fourth 35 U.S.C. § 103 Rejection

Claim 38 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hon, in view of Carlson, as applied to claim 17 and further in view of U.S. Patent No. 5,800,179 to Bailey. This rejection is respectfully traversed. However, Claim 38 is allowable for being dependent on an allowable base claim. Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,
THELEN REID BROWN RAYSMAN & STEINER LLP

Dated: July 10, 2008

/Suvashis Bhattacharya/
Suvashis Bhattacharya
Reg. No. 46,554

THELEN REID BROWN RAYSMAN & STEINER LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax (408) 287-8040